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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,783	10/02/2000	William J. McBride	018733/0997	1348

7590 03/27/2002

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EXAMINER

BHATTI, TAHIRA H

ART UNIT PAPER NUMBER

1627

DATE MAILED: 03/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/676,783

Applicant(s)

MCBRIDE ET AL.

Examiner

Tahira H Bhatti

Art Unit

1627

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 24-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 24-44 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

#### **Status of the claims:**

1. **Claims 1-23 have been cancelled by the applicant's preliminary amendment, Dated, 10/2/2000.**
2. **The preliminary amendment added claims 24-44.**
3. **Claims 1-44 are currently pending.**
4. Please Note: In an effort to enhance communication with our customers and reduce processing time, a dedicated Fax machine is in place to receive your responses. The fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Ph.D., Supervisory Patent Examiner at [jyothsna.venkat@uspto.gov](mailto:jyothsna.venkat@uspto.gov) or 703-308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

#### ***Election/Restrictions***

5. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 24-44 (in part), drawn to a method of treating a tumor by administering a radiolabeled peptide, classified in class 514, subclass 2+.
  - II. Claim 24-44 (in part), drawn to a method of treating an infectious lesion by administering a radiolabeled peptide, classified in class 514, subclass 2+.

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- III. Claim 24-44 (in part), drawn to a method of treating a myocardial infarction by administering a radiolabeled peptide classified in class 514, subclass 2+.
- IV. Claim 24-44, (in part) drawn to a method of treating a clot by administering a radiolabeled peptide classified in class 514, subclass 2+.
- V. Claim 24-44 (in part) drawn to a method of treating an atherosclerotic plaque by administering a radio-labeled peptide, classified in class 514, subclass 2+.
- VI. Claim 24-44 (in part), drawn to a method of treating a normal organ by administering a radiolabeled peptide classified in class 514, subclass 2+.
- VII. Claim 24-44 (in part), drawn to a method of treating a tissue by administering a radiolabeled peptide classified in class 514, subclass 2+.

6. Each group (I-VII) is drawn to a separate and distinct invention. The Radiolabeled peptide is used to treat eight (i.e. in groups, 1-VII) distinct and separate diseases. Art anticipating or rendering obvious one group would not anticipate or render obvious the other groups. Each group will support separate patent. Because each disease is different from the other and the method of treatment is different and distinct from the other and is independent and/or distinct invention. Each individual method of treating a distinct diseased condition, would be distinct, because of distinct object, and would require separate and/or divergent manual /computer search, which are separately and individually burdensome.

7. Because these inventions are distinct for the reasons given above:
  - a. And have acquired a separate status in the art because of their recognized divergent subject matter as shown by their different classification.
  - b. Require different and independent burdensome manual/computer patent and non-patent literature searches, restriction for examination purpose as indicated is proper.

#### ***ELECTION OF SPECIES***

8. This application contains claims directed to the following patentably distinct species of the claimed invention: Group I- VII are generic to plurality of disclosed patentably distinct species comprises a peptide that consists of a radio-metal binding moiety selected from a group in claim 41 (spec. page 8, line 27 to page 9, line 22), that is patentably distinct species, comprising specific amino acid sequences which encompass a potentially large number of diverse peptide of different sequence ( e.g. length and composition). Each peptide is distinct from the other and is independent and/or distinct invention, since a single difference in an amino acid sequence can have a dramatic effect on the function of the proteins. These species are distinct inventions due to their chemical structure and physiological, and biochemical properties, that are capable of separate manufacture and/or use; and each individual compound would use distinct methods steps, would have different object of producing it, and require separate and/or divergent manual /computer search, which are separately and individually burdensome. Therefore an election of species is required as set forth below.

The applicant is required to elect:

9. A single disclosed peptide (i.e. a single sequence ID NO:) that comprises a radio-metal binding moiety, contained in claim 41.
10. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.
12. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species, MPEP § 809.02(a).
13. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.
14. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one


or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

**15. General information regarding further correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Tahira Bhatti whose telephone number is (703) 605-1203. The examiner can normally be reached on Monday to Friday from 8:00 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsana Venkat (art unit 1627), can be reached at (703) 308 0570.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (702) 308-0196

Tahira Bhatti (art unit 1627)  
Feb. 14. 20002.

  
DR. JYOTHSNA VENKAT PH.D  
SUPERINTENDING PATENT EXAMINER  
TECHNOLOGY CENTER 1600



# RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

FIRM:

PAGES, INCLUDING COVERSHEET:

PHONE NUMBER: (703) 605-1203

TO EXAMINER: Tahira Bhatti

ART UNIT: 1627

SERIAL NUMBER: 09/676,783

FAX/TELECOPIER NUMBER: (703) 308-4315

**PLEASE NOTE: THIS FACSIMILE NUMBER IS TO BE USED ONLY  
FOR RESPONSES TO RESTRICTIONS.**

COMMENTS: \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

IF YOU HAVE NOT RECEIVED ALL THE PAGES OF THIS TRANSMISSION, PLEASE CONTACT THE ATTORNEY AT THE TELEPHONE NUMBER LISTED ABOVE.

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